

REMARKS

Applicant acknowledges with appreciation the withdrawal of rejections over Kawamura. In response to new rejections raised in this Office Action, as discussed in more detail below, Applicant cancels claims 15-16 without prejudice to expedite the prosecution of this application, and files a Terminal Disclaimer to overcome the double patenting rejection.

Double Patenting Rejection

In Paragraph 2, the Office Action provisionally rejects claims 1-17 under judicially created doctrine of double patenting over claims 1-16 of a co-pending patent application entitled "Surface Modified Encapsulated Inorganic Resist" and having a Serial No. 10/082,399.

In response to this rejection, Applicant files the enclosed Terminal Disclaimer that disclaims any portion of a patent issued based on the present application that may extend beyond the patent term of any patent issued based on the '399 application.

Filing of the Terminal Disclaimer is believed to overcome the double patenting rejection.

Rejections Under 35 U.S.C. 102

The Office Action rejects claims 15-17 as being anticipated by U.S. Patent No. 4,336,319 of Nagashima.

Claims 15-16 are canceled without prejudice, as shown above in the listing of claims, in order to expedite the prosecution of the present application. Hence, this ground for rejection is now moot and substantive remarks regarding rejections of these claims based on Nagashima are not provided.

The cancellation of these claims is not intended as an admission that Applicant agrees with the Examiner's assertion that the claims are anticipated by Nagashima. Rather, the claims are canceled to expedite allowance of the present application. Applicant reserves the right to pursue the canceled claims in future continuing applications.

Claim 17 depends on claim 1, and further recites that the core particles have an average size less than about 5 nm. The filing of the Terminal Disclaimer is believed to place claim 1 in condition for allowance. Hence, claim 17 is also believed to be in condition for allowance.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and allowance of the application. Applicant invites the Examiner to call the undersigned if there are any remaining issues.

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Respectfully submitted,

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